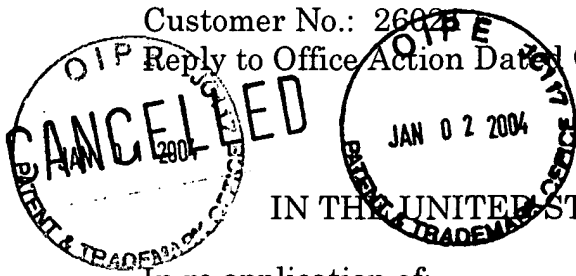


Serial No. 09/894,447

Customer No.: 2682

Reply to Office Action Dated October 2, 2003

PATENT  
83373.0002



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Franklin W. Dabby, et al.

Serial No: 09/894,447

Filed: June 28, 2001

For: PARTICLE DEPOSITION SYSTEM AND  
METHOD

Art Unit: 1731

Examiner: Christopher A.  
Fiorilla

**RESPONSE TO ELECTION OF  
SPECIES REQUIREMENT**

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David H. Ben-Meir, Reg. No. 46,152

Name

12/30/2003

Signature

Date

Dear Sir:

In response to the Office Action mailed October 2, 2003, with the period to  
respond extended to January 2, 2004, Applicants provisionally elect claims 1-6 and  
27. Applicants request reconsideration and withdrawal of the Office Action's  
restriction requirement, in view of the following remarks.

**REMARKS**

The Office Action of October 2, 2003 states that claims 1-51 are pending in  
the application. However, in a Preliminary Amendment filed April 22, 2002 (see an  
attached copy of the Preliminary Amendment), Applicants canceled claims 9-10, 12-  
21, 23-26, and 36-43. Accordingly, only claims 1-8, 11, 22, 27-35 and 44-51 are

pending in the present application. In addition, in the same Preliminary Amendment, claim 7 was amended.

The Office Action does not consider the Applicants' Preliminary Amendment of April 22, 2002, which reduced the number of claims for examination from 51 to 27, and amended claim 7. Also, the Office Action does not remark upon the disposition of claim 28.

### **RESTRICTION OF INVENTIONS**

The Office Action restricts the claims into three distinct groups. As stated in the Office Action, Group I claims 1-27 are drawn to a deposition system (apparatus). Group II claims 29-31 are drawn to a product, and Group III claims 32-51 are drawn to methods. The Office Action states that the apparatus as claimed can be used to practice another materially different process such as one which produces a non-silica material (comparing Groups I and III in Paragraph No. 2); that the products as claimed can be made by another materially different process, such as one wherein the silica is deposited on a mandrel, removed from the mandrel and then filled with core material (comparing Groups II and III in Paragraph No. 3); and that the apparatus as claimed can be used to make a different product, such as a non-silica based product (comparing Groups I and II in Paragraph No. 4).

Applicants hereby elect the "Deposition System" inventions of Group I drawn to claims 1-27, with traverse. Regarding the assignment of claims into groups, Applicants note that as a result of the Preliminary Amendment of April 22,

2002, Group I now only includes claims 1-8, 11, 22 and 27. Also, a disposition of independent claim 28 has not been included in any of the three Groups.

Applicants respectfully disagree with the reasons for requiring restriction into the three Groups. With respect to the reason given in Paragraph No. 2 for distinguishing Group III from Group I, the apparatus claims *cannot* be used to practice another materially different process such as one that produces non-silica material because each of these apparatus claims in Group I includes the limitation of "depositing silica". The recitation of "depositing silica" requires that the apparatus claims practice a process in which a silica-based material is produced.

For the same reasons, with respect to the basis for restriction given in Paragraph No. 4 for distinguishing Group I and Group II, the apparatus claims *cannot* be used to make a different product such as a non-silica based product. The recitation of "depositing silica" requires that the apparatus claims produce a silica-based product.

Furthermore, Applicants respectfully disagree with the reason given in Paragraph No. 3 for distinguishing Group III from Group II, that the products as claimed can be made by another materially different process, such as one wherein the silica is deposited on a mandrel, removed from the mandrel, and then filled with core material. First, the Office Action does not explain how the example provided of a materially different process used to manufacture the product as claimed is *in fact* materially different from the claimed processes. The steps in the example process

recited in the Office Action are not materially different of the steps recited in Applicants' process claims. That is, the steps recited in the Office Action do not necessarily recite a materially different process, but potentially only additional steps in the same or a not-materially-different process.

Notwithstanding the above provisional election and remarks, Applicants respectfully request that the restriction requirement be reconsidered. The number of claims in the application has been reduced and a combined search and examination of Group I, Group II and Group III would not pose a serious burden to the Office. See MPEP § 803 and 808.02.

The Office Action states that the inventions identified by the three Groups are distinct, have acquired a separate status in the art, and that therefore restriction for examination purposes is proper. However, in accordance with MPEP § 803, restriction is appropriate only when the groups are shown to be distinct and when there would be a "serious burden" placed on the Examiner to examine the claims without restriction. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." MPEP § 803 (emphasis added). Each group of claims in the present application relate generally to systems, methods for depositing silica, or products of the deposition of silica-based material. Some of the claim limitations present throughout Group I are also present in Group II and Group III or have parallel limitations in Group II and

Group III. Therefore, the groups defined in the Office Action would nonetheless likely require the Examiner to search the same subclasses and consider the same prior art references. Consequently, Applicants maintain that the examination of all of the pending claims together will not place a serious burden upon the Examiner.

In view of the foregoing remarks, Applicants respectfully request that the Examiner reconsider and withdraw the Restriction Requirement, and examine all pending claims on the merits.

### **ELECTION OF SPECIES**

The Office Action has segregated the subject matter recited by the claims in Groups III and I into four species each. The Office Action requires that in addition to the election of one of the three Groups, an election of one of the following species depending on the Group that is elected:

#### **Deposition System species:**

- a. system including a burner (e.g. claim 1)
- b. system including a gas panel (e.g. claim 7)
- c. system including an intake system (e.g. claim 12) (now canceled)
- d. system including a vaporizer (e.g. claim 23) (now canceled);

#### **Method species:**

- e. method of manufacturing a fiber perform[sic] (e.g. claim 32);
- f. method of manufacturing a silica rod (e.g. claim 33);

- g. method of manufacturing silica wafers(e.g. claim 34);
- h. method of manufacturing an optical fiber (e.g. claim 35); [sic]

**Applicants hereby elect the “Deposition System” species “a”, with traverse.** Pending claims 1-6 and 27 of Group I appear to comprise the “Deposition System” species (a) claims. Accordingly, Applicants elect examination of claims 1-6 and 27, with traverse. Accordingly, an action on the merits of the claims readable on the elected species is respectfully requested.

Applicants respectfully traverse the Election of Species requirement in the Deposition System species and the Method species in Paragraph No. 6 of the Office Action.

First, as discussed above, Applicants previously canceled claims in accordance with the Preliminary Amendment filed April 22, 2002. The previously canceled claims include claims 12-21 specified in the Office Action as comprising Deposition System species (c) and claims 23-26 specified in the Office action as comprising Deposition Species (d). Thus, only two Deposition System species (a) and (b), as the Examiner has defined them, remain pending. Consequently, Applicants maintain that the examination of all of the pending Deposition System species claims will not place a serious burden upon the Examiner.

Furthermore, the Office Action does not include any reasons for insisting upon restriction between these two species. MPEP § 808.

The Office Action also does not include any reasons for insisting upon restriction between the species (e, f, g and h) within the Method species (including claims 32-35 and 44-51 after the Preliminary Amendment). The methods recited by the Method species claims, although directed to distinct products, recite many of the same steps. Accordingly, as discussed above in connection with the restriction into the three Groups, Applicants maintain that the examination of all pending method claims will not place a serious burden upon the Examiner.

The Examiner is respectfully requested to withdraw the Election of Species requirement.

### Conclusion

Applicants elect claims 1-6 and 27, which Applicants believe comprise Deposition System species (a) of Group I, with traverse. Applicants traverse the requirement for election for the reasons discussed in the foregoing Remarks. In view of the foregoing Remarks, Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement, and examination of all pending claims on the merits.

If other fees are due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

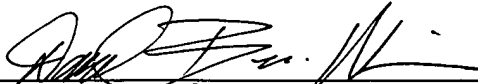
Serial No. 09/894,447  
Customer No.: 26021  
Reply to Office Action Dated October 2, 2003

PATENT  
83373.0002

Respectfully submitted,

HOGAN & HARTSON L.L.P.

Dated: December 30, 2003

By: 

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